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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/446,951 | 02/28/2000 | STEPHEN JAMES DAVIS | 8697-001-27P | 3194 |

7590 06/20/2002

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EXAMINER

CUFF, MICHAEL A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3627

DATE MAILED: 06/20/2002

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/446,951

Applicant(s)

Davis

Examiner

Michael Cuff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 7, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 6-34, and 36-38 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1, 3, 6-34, and 36-38 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

Examiner's Note

1. The current application has taken many twists and turns. The applicant elected one invention, but then amended to read on another. The examiner didn't catch this and did not hold that amendment to be non-responsive. Different attorneys are prosecuting the case. There have been discussions and arguments made over 35 USC 112, first paragraph rejections. The examiner believes it would be best to start over.

In starting over, the examiner found many 35 USC 112, second paragraph problems and drawing objections with respect to the independent claims which have crept into the claims by amendments. For example, the term "hitch assembly" is positively recited in the independent claims, but it is not clear which elements in the specification constitute this assembly. Item 80, in figure 6, is not a gooseneck as recited in the specification. The terms "a hitch portion", "a vehicle hitch", "a rear portion of a vehicle", and "forward" are positively recited in the independent claims and are all unclear or raise issues of combination/subcombination issues.

In order to further prosecution with a clean slate, the examiner would like to respond to the 35 USC 112, first paragraph discussion.

In reference to claim 3, applicant asserts that, because the specification recites "the mounting portion may take any suitable form dictated by the form of the towing hitch", the applicant has disclosed the "mounting portion includes a body member adapted to engage a

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tubular socket of a towing hitch". First, what constitutes the term "a towing hitch"? Is that the same as a "hitch assembly"? Second, the examiner was willing accept applicant's statement of a broad disclosure. However, applicant had to amend the independent claims to overcome prior rejections which add specific positional details about the step portion and the mounting portion. These positional details for an embodiment, not shown, make the claimed invention of claim 3 not enabled.

In reference to claims 36 and 37, drawn to figures 5 and 6, the examiner understand the enablement of locking the step in one position or another. The problem lies in the claimed limitation "whereby said hitch is unable to be unhitched [hitched] therefrom [or thereto]". Therefrom or thereto what? If one takes off bolts 64 or nut 84, the hitches are unhitched from the tow vehicle, therefore the limitation is not enabled as claimed.

In starting over, claim 38 is no longer considered to be allowable. The following restriction is proper per CFR 1.142(a). The examiner has made two call to attorney Rebecca Goldman Rudich to try to resolve this issue over the phone with no return response call back. The examiner requests that applicant tries to resolve the above issues while electing a species.

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Election/Restrictions

2. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

- Species I Figures 1, 2, and 4 drawn to a step apparatus in lieu of a hitch.
- Species II Figure 3 drawn to a step apparatus built upon a ball hitch.
- Species III Figure 5 drawn to a pintle hook hitch with a step assembly.
- Species IV Figure 6 drawn to a ball hitch with a step assembly.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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The none of the claims are generic.

3. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The shown steps have only the feature of a step in common which is not considered to be a "special technical feature" in defining a "step apparatus". Species I thru IV fail to meet the criteria of a group of inventions so linked as to form a single general inventive concept as set forth in MPEP 1850 and 1893.03(d).

A telephone call was made to Rebecca Goldman Rudich on 6/10/02 to request an oral election to the above restriction requirement, but did not result in an election being made. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Conclusion

4. Any inquiry concerning this communication should be directed to Michael Cuff at telephone number (703) 308-0610. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113. The fax phone number for this Group is (703) 872-9326. (After Final special fax number (703) 872-9327) The customer service number is (703) 872-9325.

Michael Cuff 6/19/02
Michael Cuff
June 19, 2002